



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,962	07/03/2003	Hiroshi Inoue	0054-0277P	3566

2292 7590 04/24/2007
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

SMARTH, GERALD A

ART UNIT	PAPER NUMBER
----------	--------------

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/24/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/24/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/611,962	Applicant(s) INOUE ET AL.	
	Examiner Gerald Smarth	Art Unit 2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/10/06, 8/29/05, 7/20/04, 7/3/03</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is being rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 states " A print service system according to claim 1, wherein when a mail address of another user except said user is described in a body of the electronic mail received by said electronic mail receiving means, said user designation managing means transmits a user ID and a password to said mail address of the another user simultaneously with transmitting said user ID and said password to said mail address of the user." This claim is not clear to examiner as to what is being stated. The phrase "said mail address of the another user" is not clear.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim1-3, 8-12 rejected under 35 U.S.C. 102(e) as being anticipated by Akinori Iwase(US 2002/0046247A1).

Claim 1 states "A print service system comprising: electronic mail receiving means connected with a network, for image data receiving an electronic mail including attached transmitted from a user through the network; user designation managing means for making a user ID and a password for a mail address used by said user, and transmitting said user ID and said password to said mail address; data accumulating means for storing image data received by said electronic mail receiving means for each user ID; and at least one print means connected with the network, for downloading said image data from said data accumulating means through the network when said user ID and said password are inputted, and printing said image data." This is being anticipated by Iwase. Iwase states "an electronic mail function is provided as one of the functions provided by the groupware server 2. That is, the groupware server is utilized by a personal computer or work station connected o the network." (page 2 paragraph 44). He also claims, in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name (page 4

Art Unit: 2109

paragraph 70). Thus, communication traffic for transmitting the attached file to the portable telephone can be saved and the contents of the attached file can be stored so as to be utilized by the user (page 5 paragraph 110). First, the user inputs a user ID and password by operating the touch panel 43a and operating panel 44 when the attached file stored in the Internet binder 3 is printed by use of the MFP4. (page 6 paragraph 115)

Claim 2 states "A print service system according to claim 1, further comprising usage guide displaying means connected with the network, for displaying a usage guide including information related to an installation location of said print means.

This is being anticipated by Iwase. Iwase states "Fig.19 is a diagram showing a display example in which the file list received from the Internet binder 3 is displayed on the display section 43. In this case, a file can be selected by touching the file displayed on the display section 43 of the touch panel 43a. In the display example shown in FIG. 19, the above file selection screen is display section 43." (page 6 paragraph 120)

Claim 3 states "a print service system according to claim 1, wherein: said print means includes a touch panel; and said user ID and said password are inputted from an input unit composed of a ten-key pad which is displayed on said touch panel. Fig 14. is a diagram showing a display example when a mail is received from the portable telephone 1 and log-in (access) is made from the portable telephone 1 to the groupware server 2. In the display example of Fig. 14, a user ID input column and a password input column are displayed." (page 5 paragraph 100)

Claim 7 states "A print service program for causing a computer connected through a network with a server which receives an electronic mail including attached image data transmitted from a user and makes a user ID for a mail address used by the user, to execute the method of: inputting the user ID downloading through the network the attached image data stored in the server when the user ID is inputted in said user ID input step; and printing the attached image data downloaded." This is being anticipated by Iwase. Iwase states that "First, the user inputs a user ID and password by operating the touch panel 43a and operating panel 44 when the attached file stored in the Internet binder3 is printed by use of the MFP." (page 6 paragraph 115).

Claim 8 states " A print service program for causing a computer connected through a network with a server which receives an electronic mail including attached image data transmitted from a user and makes a user ID for one of the attached image data and the electronic mail, to execute the method of: inputting the user ID; downloading through the network the attached image data stored in the server when the user ID is inputted in said user ID input step; and printing the attached image data downloaded. "

This is being anticipated by Iwase. Iwase states that " In the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name." (page 4 paragraph 70). "The portable telephone 1 is connected to the groupware server 2 to transmit or receive data. Thus, the portable

telephone 1 can receive an electronic mail (which is hereinafter simply referred to as a mail) from the groupware server 2.” (page 2 paragraph 42). “First, the user inputs a user ID and password by operating the touch panel 43a and operating panel 44 when the attached file stored in the internet binder 2 is printed by use of the MFP 4. “ (page 6 paragraph 115).

Claim 9 states “A print service program for causing a computer connected through a network with a server which receives an electronic mail including attached image data transmitted from a user and makes a user ID and a password for a mail address used by the user, to execute: a user ID input step for inputting the user ID and the password; an image data obtaining step for downloading through the network the attached image data stored in the server when the user ID and the password are inputted in said user ID input step; and a print step for printing the attached image data downloaded.” This is being anticipated by Iwase. Iwase states that The portable telephone 1 is connected to the groupware server2 to transmit or receive data. Thus, the portable telephone 1 can receive an electronic mail(which is here- inafter simply referred to as a mail) from the groupware server. (page 2 paragraph 42). While the above input screen is being displayed, the user inputs a user ID and password. Then, if the input user ID and password meet the requirement, the user touches the “log-in” key by use of the touch panel 43a. (page 6 paragraph 117). Fig. 20 shows a display example of the print setting screen. If the user selects “print” on the print setting screen, the MFP 4 prints the file transferred from the Internet binder 3. (page 6 paragraph 123)

Claim 10 states "A print service program for causing a computer connected through a network with a server which receives an electronic mail including attached image data transmitted from a user and makes a user ID and a password for one of the attached image data and the electronic mail, to execute: a user ID input step for inputting the user ID and the password; an image data obtaining step for downloading through the network the attached image data stored in the server when the user ID and the password are inputted in said user ID input step; and a print step for printing the attached image data downloaded."

This is being anticipated by Iwase. Iwase states "In the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name." (page 4 paragraph 70). "Fig. 18 shows a display example of an input screen of the user ID and password. In the input screen shown in Fig. 18, a user ID input column, password input column, "return" key and "log-in" key are displayed on the display section 43. The "return" key and "log-in" key are keys which can be selected by use of the touch panel 43a. (page 6 paragraph 116) While the above input screen is being displayed, the user inputs a user ID and password. Then, if the input user ID and password meet the requirement, the user touches the "log-in" key by use of the touch panel 43a. (page 6 paragraph 117). Fig. 20 shows a display example of the print setting screen. If the user selects "print" on the print setting screen, the MFP 4 prints the file transferred from the Internet binder 3. (page 6 paragraph 123).

Claim 11 states "A print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; a user ID creation step for making a user ID for a mail address used by the user; a user ID transmission step for transmitting the user ID to the mail address; and a data accumulation step for storing the attached image data for each user ID." This is being anticipated by Iwase. Iwase states "" In the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name. "(page 4 paragraph 70). The MFP4 transmits the user ID and password and effects a process for connection to the Internet binder 3. If connection to the Internet binder 3. If connection with the MFP 4 is made, the Internet binder 3 transmits a stored list of files corresponding to the user ID transmitted from the MFP 4 to the MFP 4. (page 6 paragraph 118)

Claim 12 states "A print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute: an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; a user ID creation step for making a user ID for one of the attached image data and the electronic mail; a user ID transmission step for transmitting the user ID to a mail address used by the user; and a data accumulation step for storing

Art Unit: 2109

the attached image data for each user ID. "This is being anticipated by Iwase. Iwase states "In the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name. "(page 4 paragraph 70). The MFP4 transmits the user ID and password and effects a process for connection to the Internet binder 3. If connection to the Internet binder 3. If connection with the MFP 4 is made, the Internet binder 3 transmits a stored list of files corresponding to the user ID transmitted from the MFP 4 to the MFP 4 (page 6 paragraph 118).

5. Claim 13 being rejected under 35 U.S.C. 102(e) as being anticipated by Petrogiannis et al (2002/0078159).

Claim 13 states "A print service program for causing a computer connected through a network with a print terminal which performs authentication using a user ID and prints designated image data, to execute:
an electronic mail reception step for receiving an electronic mail including attached image data transmitted from a user through the network; a judgment step for judging whether or not a mail address of another user except the user is described in a body of the electronic mail received; a user ID creation step for making a user ID and a password for a mail address used by the user and the mail address of the other user when it is judged that the mail address of the other user is described in said judgment step; a user ID transmission step for transmitting the user ID and the password which are made in the user ID creation step to the mail address of the user and the mail

Art Unit: 2109

address of the other user; and a data accumulation step for storing the attached image data for each user ID. " is being anticipated by Petrogiannis et al (2002/0078159) .

Petrogiannis states "The present invention also provides a method for a proponent to enable the secure approval of at least one electronic document by a plurality of correspondents over a network, each correspondent having a correspondent terminal connected to the network." (page 1 paragraph 18) Petrogiannis also states There is a Iso provided in accordance with yet another aspect of the present invention a system for a proponent to enable the secure approval of an electronic document by a correspondent over a network, this system including: (page 2 paragraph 27) a server application provided on a proponent server connected to the network, the server application comprising approval tools for the secure approval of the electronic document; (page 2 paragraph 28) transmitting the electronic document from the propend server to a correspondent terminal connected to the network; and (page 2 paragraph 29) a correspondent application provided on the correspondent application allowing the correspondent to remotely access the approval tools on the proponent server through the network from the correspondent terminal, and approving the electronic document on the correspondent terminal using the approval tools accessed by the correspondent application." (page 2 paragraph 30)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2109

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-6, 14 & 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwase(2002/0046247) as applied to claim above, and further in view of Petrogiannis(2002/0078159).

Claim 4 states "A print service system according to claim 1, wherein when a mail address of another user except said user is described in a body of the electronic mail received by said electronic mail receiving means, said user designation managing means transmits a user ID and a password to said mail address of the another user simultaneously with transmitting said user ID and said password to said mail address of the user."

Iwase teaches claim 1. Iwase states" an electronic mail function is provided as one of the functions provided by the groupware server 2. That is, the groupware server is utilized by a personal computer or work station connected o the network. (page 2 paragraph 44). He also claims, in the item of the password, a password given to the user is recorded. In the item of the user ID, a user ID given to the user is recorded. The user ID may be the same as the account name or may be different from the account name(page 4 paragraph 70). Thus, communication traffic for transmitting the attached file to the portable telephone can be saved and the contents of the attached file can be stored so as to be utilized by the user(page 5 paragraph 110). First, the user inputs a user ID and password by operating the touch panel 43a and operating panel 44 when the attached file stored in the Internet binder 3 is printed by use of the MFP4. Iwase

Art Unit: 2109

doesn't teach "wherein when a mail address of another user except said user is described in a body of the electronic mail received by said electronic mail receiving means, said user designation managing means transmits a user ID and a password to said mail address of the another user simultaneously with transmitting said user ID and said password to said mail address of the user."

Petrogiannis teaches sending the address of other users for access to attachment via user id and password. Petrogiannis states "The present invention also provides a method for a proponent to enable the secure approval of at least one electronic document by a plurality of correspondents over a network, each correspondent having a correspondent terminal connected to the network." (page 1 paragraph 18) "The correspondent logs in by entering the user ID and password that was included in the body of the e-mail message." (page 6 paragraph 100) "The plug-in queries the enrollment engine at the proponent server to obtain a user ID and password for that particular correspondent's enrollment, defining the enrollment information. This information is then inserted into the e-mail by the client plug-in of the proponent along with a URL to the enrollment page, and attaches the document to the e-mail. The e-mail with the enrollment information and the attached document is then sent to the correspondent." (page 6 paragraph 125 line 11) Petrogiannis is for teaching that multiple users having access to an attachment using a user specific user id and password via email. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify emails with user Id and password protected attachments as being taught by lwase, to show multiple users can have

Art Unit: 2109

access to this or these attachments in emails by using a user id and password which was given through a server and was specified by another user via email as stated by Petrogiannis.

Claim 5 states "A print service system according to claim 4, wherein said user ID and said password which are transmitted to said mail address of another user except said mail address of said user are identical to said user ID and said password which are transmitted to said user's mail address."

Transmitting identical user ID and the password to said user mail address and of other user mail address is considered inherent for sending out the same user ID and password to multiple users. This can be interpreted as giving multiple users the same access.

Claim 6 states "A print service system according to claim 4, wherein said user ID and said password which are transmitted to said mail address of another user except said mail address of said user are different from said user ID and said password which are transmitted to said user's mail address."

This claim is considered inherent for sending out the different user ID and password for multiple users. This can be interpreted as giving multiple users the different access.

Claim 14 states "A print service program according to claim 13, wherein the user ID and the password which are transmitted to the mail address of the other user are identical to the user ID and the password which are transmitted to the mail address of the user." Transmitting identical user ID and the password to said user mail address and of other user mail address is considered inherent for sending out the same user ID

Art Unit: 2109

and password to multiple users. This can be interpreted as giving multiple users the same access.

Claim 15 states "A print service program according to claim 13, wherein the user ID and the password which are transmitted to the mail address of the other user are different from the user ID and the password which are transmitted to the mail address of the user." This claim is considered inherent for sending out the different user ID and password for multiple users. This can be interpreted as giving multiple users the same access.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Smarth whose telephone number is (571)270-1923. The examiner can normally be reached on Monday-Friday(7:30am-5:00pm)est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu can be reached on (571)272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2109

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Supervisory Patent
Examiner